IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants:	John Hood et al.	)	
Application No.	09/637,302	)	
Filed:	August 11, 2000	)	Group Art Unit: 1652
For:	METHODS AND COMPOSITIONS USEFUL FOR MODULATION OF ANGIOGENESIS USING TYROSINE KINASE RAF AND RAS	)	
Examiner:	Rebecca E. Prouty	)	Attorney Docket No. TSRI 710.2

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
Washington, D. C. 20231

Sir:

In response to the requirement for restriction dated 2 October 2002, applicants hereby provisionally elect for further prosecution at this time the claims of Group I, i.e., claims 1-6, 14-16 and 41 drawn to pharmaceutical compositions of kinase active Raf. This election is made with traverse.

Reconsideration of the present 20-way restriction requirement is requested.

It is noted that the grouped claims are classified in either class 424, subclass 94.5, or class 514, subclass 44. In particular, Groups I, II, V, VI, IX, X, XIII, XIV, XVII and XVIII are all classified in class 424, subclass 94.5, while groups III, IV, VII, VIII, XI, XII, XV, XVI, XIX and XX are all classified in class 514, subclass 44. Accordingly, a single search will provide pertinent art for the claims in Groups I, II, V, VI, IX, X, XIII, XIV, XVII and XVIII. Thus at least the claims of the foregoing groups should be examined together. Likewise, a single search will provide pertinent art for the claims in Groups, III, IV, VII, VIII, XI, XII, XV, XVI, XIX and XX, thus at least the claims of these particular groups should be examined together. The M.P.E.P. §808.02 provides guidance here:

> Where, however the classification is the same and the field of search is the same and there is no clear indication of separate classification and field of search, no reasons exist for dividing among related inventions. (Emphasis added).

It is also submitted that the Requirement for Restriction is not mandatory under 35 U.S.C. §121 and 37 C.F.R. §1.142, but is merely discretionary. This observation is particularly important in light of court decisions which have indicated that an improperly made Restriction Requirement would not preclude a holding of double patenting, despite the language of 35 U.S.C. §121, third sentence. See, for example, Eversharp, Inc. v. Phillip Morris, Inc., 256 F. Supp. 778, 150 U.S.P.Q. 98 (E.D.Va. 1966); aff'd 374 F.2d 511, 153 U.S.P.Q. 91 (4th Cir. 1967). Therefore, to promote the interest of both the public as well as the applicants, the Restriction Requirement should not be imposed without a specific analysis which supports the conclusions that two or more independent and distinct inventions are indeed claimed in one application.

The courts have recognized the advantages of the public interest to permit patentees to claim all aspects of their invention, as the applicants have done herein, so as to encourage the patentees to make a more detailed disclosure of all aspects of their invention. The Court has observed:

> We believe that the constitutional purpose of the patent system is promoted by encouraging applicants to claim, and therefore to describe in the manner required by 35 U.S.C. § 112, all aspects of what they regard as their invention, regardless of the number of statutory classes involved.

In re Kuehl, 177 U.S.P.Q. 250, 256 (C.C.P.A. 1973).

Furthermore, applicants respectfully submit that in view of increased Official Fees and the need to file divisional applications substantially concurrently, a practice which arbitrarily imposes a Restriction Requirement may become prohibitive, and thereby contravenes the constitutional intent to promote and encourage the process of science and the useful arts.

Hence, it is respectfully requested that the Examiner reconsider and withdraw the outstanding Restriction Requirement, and provide an action on the merits with respect to

all of the claims, or at least as to the claims in Groups I, II, V, VI, IX, X, XIII, XIV, XVII and XVIII.

Respectfully submitted,

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